

REMARKS

Claims 1-19 are pending in the application. No claim amendments are made in this response. Reconsideration of the application is respectfully requested based on the following remarks.

I. REJECTION OF CLAIMS 17-19 UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 17-19 were rejected under the doctrine of obviousness-type double patenting, as being unpatentable over claims 1, 2 and 9 of U.S. Patent No. 6,088,368 in view of U.S. Patent No. 6,055,268 (Timm et al.). While applicant respectfully disagrees with the rejection, a terminal disclaimer is filed herewith to expedite prosecution in this matter, thereby rendering the above issue moot. Accordingly, withdrawal of the rejection is respectfully requested.

II. REJECTION OF CLAIMS 1-5, 8-9 AND 11-19 UNDER 35 U.S.C. § 102(e)

Claims 1-5, 8-9 and 11-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,055,268 (Timm et al.). Withdrawal of the rejection is respectfully requested for at least the following reasons.

- i. Timm et al. do not teach a modem comprising a data collection and reorganization unit that is configured to assemble upstream DSL signals into a single Ethernet signal for transmission, as recited in claims 1, 17 and 19.*

Claim 1 is directed to a modem for bi-directional transport of an Ethernet signal over a configurable number of telephone lines. The modem comprises a data collection and reorganization unit that is ***configured to assemble upstream DSL signals into a***

single Ethernet signal. Claims 17 and 19 also recite a data collection and reorganization unit. Timm et al. do not teach this feature.

The gist of applicant's previous argument on pages 9-10 of the response of March 10, 2009, was that the DSL router 330 of Timm et al. does not combine signals received at its ports from the device 340, 342 and 344 into a single Ethernet signal, and thus Timm et al. do not disclose a data collection reorganization unit as claimed. The Office Action of June 15, 2009, disagreed, stating:

Fig. 3b shows "MDSL modem" acting as a router. But it is still a MDSL modem. DSL modems that manage connection with a group of machines are termed as [a] DSL router. But they still have [the] function of performing framing data, segmenting data and reassembling data. Timm discloses MDSL modem that sends and receives the data from MDSL ports and Ethernet ports. It is inherent to sequence, split and re-assemble the data frames. Thus, Timm discloses a data collection reorganization unit as claimed in claims 1, 17 and 19. (O.A., 6/15/09, p. 19, paragraph 13).

Applicant respectfully disagrees with the above assertion.

Initially, the principle of anticipation based on inherency is clear. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art. Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991)(Emphasis added). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Id. at 1269.

It is respectfully submitted that Timm et al. fail to anticipate the claimed invention under the doctrine of inherency because there is no disclosure in Timm et al. that the DSL router 330 operates to assemble the upstream DSL signals into a single Ethernet signal for transmission as claimed. Further, there is no implication in the cited art that such functionality must necessarily occur. Col. 16, lines 9-11 of Timm et al. simply

states that ***the DSL modem 330 acts as a router*** for the LAN 320. No language in the reference indicates that it also performs an re-assembling of data, nor would such functionality be required or necessary.

While the modem 330 could hypothetically split and re-assemble data frames from the modems 340, 342, and 344, it is unclear why this would be desirable. For example, if the modem 340 in Fig. 3b of Timm et al. constructed a packet with a header containing a destination address #1, while the modem 342 constructed another packet with a header containing a different destination address #2, the DSL modem 330, acting as a router, would not have any reason to split and re-assemble such data packets. Rather, the DSL modem 330, acting as a router as explicitly taught in Timm et al., would simply use the header destination addresses to route the packets to their respective, different destinations. Any disassembling performed by the DSL modem 330 would require a subsequent re-assembling as an interim point of receipt (resulting in undesirable delays associated therewith), as well as create inefficient routing if such destinations (dictated by the different destination addresses) were substantially disparate. That is, after re-assembling, one or both of such packets may need to be further re-routed as the destination address would not match. Clearly then, the DSL modem 330 does not ***inherently*** teach the claimed invention, and thus the cited art fails to anticipate the claimed invention.

If the Examiner chooses to maintain the rejection of the pending claims in view of Timm et al., applicant respectfully requests a detailed explanation as to how and/or why the DSL modem 330 must necessarily operate to combine multiple DSL signals into a single Ethernet signal as claimed. Further, to the extent that the previous Office Action is taking Official Notice of an alleged fact, applicant hereby requests that an explanation and supporting documentation be provided including specific factual findings predicated on sound technical and scientific reasoning to support the conclusion, as required by MPEP §2144.03 (B), (C) (*citing* 37 C.F.R. §1.104(c)(2) and In re Zurko, 258 F.3d 1386 (Fed. Cir. 2001)).

III. CONCLUSION

For at least the above reasons, the claims currently under consideration are believed to be in condition for allowance.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, REIIP101USA.

Respectfully submitted,
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